

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Andreas Renz et al.

Application No.:10/552,013

Confirmation No.: 6294

Filed: September 30, 2005

Art Unit: 1638

For: NOVEL PLANT ACYLTRANSFERASES
SPECIFIC FOR LONG-CHAINED, MULTIPLY
UNSATURATED FATTY ACIDS

Examiner: McElwain, Elizabeth F.

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed October 5, 2007, Applicants provisionally elect Group XXIV, claims 11-15, 17-23, 27 and 28, drawn to SEQ ID NO: 16, which encodes the amino acid sequence of SEQ ID NO: 17, with traverse. Reconsideration and withdrawal of the restriction requirement is strongly urged, al least for the claims drawn to the elected sequences, for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression “special technical feature” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (PCT Rule 13.2).

The Examiner argues that the inventions do not relate to a “special technical feature” which defines a contribution over the prior art, citing Lassner *et al.* (WO 00/18889). Applicants

respectfully disagree that the inventions of the present application do not make a contribution over the reference cited by the Examiner.

As stated in the specification, the general inventive concept of the present application relates to nucleic acids which code for polypeptides with acyltransferase activity and processes for the production of long-chain polyunsaturated fatty acids in an organism using said nucleic acids. See Specification at page 1, lines 3-5. As the Examiner correctly characterized, Lassner *et al.* discloses nucleic acids encoding enzymes involved in fatty acid metabolism and their use. See Official Action at page 4. Lassner *et al.*, however, does not disclose the sequences of the present invention, namely the sequence encoding the lysophosphatidic acid acyltransferase of *Mortierella* (SEQ ID NO: 16, and the corresponding amino acid sequence of SEQ ID NO: 17). Therefore, the Patent Office has not established the presence in the prior art of the special technical feature of Applicants' claims. Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine all the claims in one application.

Moreover, Applicants believe that there is no undue burden on the Examiner to search and examine all claims together. As stated in § 803 of the M.P.E.P. “[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (M.P.E.P. § 803, emphasis added). As discussed above, all claims share a common technical feature relating to a novel lysophosphatidic acid acyltransferase of *Mortierella* (SEQ ID NO: 16, and the corresponding amino acid sequence of SEQ ID NO: 17). The same art and field of search relevant to the nucleotide sequence would be also relevant to a process of use of said nucleotide sequence.

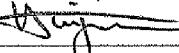
Additionally, unity of invention is further fulfilled because the claims are directed to a product and a process of use of said product, which are an acceptable combination of categories for unity pursuant to 37 CFR § 1.475(b)(3). Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine the claims in one application.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of this restriction requirement.

Applicants reserve all rights to pursue the non-elected species in one or more divisional application.

Applicants are submitting their response within the one-month response period. No fee is believed due. However, if any fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 13478-00002-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 
Hui-Ju Wu, Ph.D.

Registration No.: 57,209
CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, Delaware 19899
(302) 658-9141
(302) 658-5614 (Fax)
Agent for Applicants